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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,085	10/14/2005	Per-Ingvar Branemark	2816-3	6431
616 7590 03/30/2007 THE MAXHAM FIRM 9330 SCRANTON ROAD, SUITE 350 SAN DIEGO, CA 92121			EXAMINER WOODALL, NICHOLAS W	
			ART UNIT	PAPER NUMBER
			3733	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/30/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/540,085

Applicant(s)

BRANEMARK, PER-INGVAR

Examiner

Nicholas Woodall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-24, 29, 32, and 35-37 is/are rejected.
- 7) ☒ Claim(s) 25-28, 30, 31, 33, 34 and 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on 01/16/2007.

#### ***Drawings***

2. The drawings were received on 01/16/2007. These drawings are not acceptable for the reasons discussed below.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "1" and "2" have both been used to designate the anchoring portion on page 6 of the specification lines 4-12. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheets should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

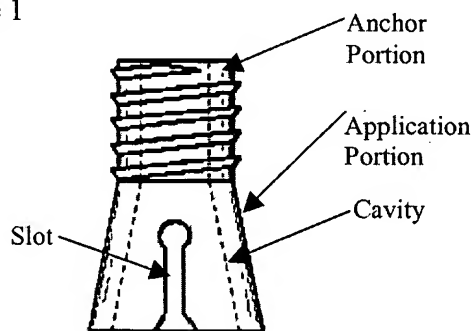
1. Claims 13-18 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Errico (U.S. Patent 6,482,207).

Regarding claim 13, Errico discloses a device comprising an anchoring portion and an application portion. The application portion has an outer end and an end connected to the anchoring portion. The application portion has a flared out portion that widens from the end connected to the anchoring portion towards the outer end. The flared portion is elastically resilient in a direction transverse to the longitudinal direction of the device. Regarding claim 14, Errico further discloses the flared out portion is formed of an outer wall surrounding a cavity that is open towards the outer end of the application portion. The flared portion also contains slots penetrating through the outer wall that connect the cavity with the outside of the outer wall. Regarding claims 15 and 16, Errico further discloses the anchor portion includes a threaded part and the flared portion has a rotationally symmetrical outer contour around the center axis defined by the threaded part. Regarding claims 17 and 18, Errico further discloses the flared portion to have a truncated cone shape. Regarding claim 23, Errico further discloses the slots define an angle of 90 degrees with the radius of the truncated cone. With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Errico, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference.

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Kalman v. Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Figure 1



### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 19-22, 24, 29, 32, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Errico (U.S. Patent 6,482,207).

Regarding claims 19-20 and 24, Errico discloses the invention as claimed except for the truncated cone having a cone angle of 5-12 degrees. It would have been obvious

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to one having ordinary skill in the art at the time the invention was made to construct the truncated cone of the device of Errico with a cone angle of 5-12 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claims 21 and 22, Errico discloses the invention as claimed except for the truncated cone having a cone angle of 7-9 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the truncated cone of the device of Errico with a cone angle of 7-9 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 29, Errico discloses the invention as claimed except for the slots having a slot angle between 20-40 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the slots of the device of Errico having a slot angle between 20-40 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 32, Errico discloses the invention as claimed except for the slots having a slot angle between 27-33 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the slots of the

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device of Errico having a slot angle between 27-33 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 35, Errico discloses the invention as claimed except for the thickness of the outer wall being 0.3-1.0. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the outer wall of the device of Errico with a thickness of 0.3-1.0 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 36, Errico discloses the invention as claimed except for the thickness of the outer wall being 0.3-1.0. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the outer wall of the device of Errico with a thickness of 0.3-1.0 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claims 37, Errico discloses the invention as claimed except for the device being made from titanium. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Errico from titanium, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

***Allowable Subject Matter***

4. Claims 25-28, 30, 31, 33, 34, and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 01/16/2007 have been fully considered but they are not persuasive. Regarding the applicant's argument that the Errico reference does not show the structural limitations of the claims. The examiner has shown that the element referenced from Errico has an anchoring portion, the threaded portion, and an application portion having an end connected to the anchoring portion and a flared out portion that widens from the end connected to the anchoring portion towards the outer end. Furthermore, the application end of the element from the Errico reference is elastically resilient in a direction that is transverse to the longitudinal axis of the element in order to grip a prosthesis or implant, such as a pedicle screw. Regarding the applicant's argument that the examiner cannot take use the locking member of the Errico reference to read upon the claims of the application, the examiner would like to first point out that the fact that the applicant uses the invention for a different purpose does not alter the conclusion that its use in a prior art device would be prima facie obvious from the purpose disclosed in the reference. Also, the examiner would like to point out that the applicant uses the term comprising and not consisting in the preamble of the claims, therefore the reference may include the elements of the claimed invention and any additional elements. Therefore, as long as the element used in the Errico



reference is capable of being used in the same manner as the applicant's invention then the rejection is proper. It is now the burden of the applicant to provide evidence that the element of Errico is unable to be used in the same manner as the applicant's invention.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



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